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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/782,498
Filing Date: February 19, 2004
Appellant(s): FARN, BRIAN

Theodore D. Fay III
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 7, 2007 appealing from the Office action mailed July 10, 2007.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-28.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are

provided under the subheading "NEW GROUNDS OF REJECTION." Specifically, claims 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2003/0142128	REULEIN	07-2003
6,202,199	WYGODNY	03-2001

(9) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reulein et al. (US2003/0142128A1) further in view of Wygodny et al. (US620219991).

Claims 1, 8, 15 and 22: Reulein discloses method, system and product for editing a plurality of column oriented programming language statements (Reulein: fig.7A and par. [0021]) presented to a user on a display screen (Reulein: fig.4: item# 202: "User Interface")), comprising: identifying a template description for at least one of the plurality of column oriented programming language statements (Reulein: fig.7A and par. [0021]), wherein the template description defines at least one statement type (Reulein: par. [0057], lines 3-11). While Reulein discloses a GUI (Fig. 3), Reulein does not disclose "a plurality of panes on a graphical user interface". However, Wygodny does disclose the at least one of the plurality of column oriented programming language statements is selectable in a first pane (Wygodny: fig. 5 item #501; Column 12, lines 54-56) of a plurality of panes on a graphical user interface (Wygodny: fig.5; Column 12, lines 54-56); and displaying one or more editable fields corresponding to the at least one statement type on a second pane (Wygodny: fig.5 items #504; Column 12, lines 54-56) of the plurality of panes (Wygodny: fig.5 items #501 and 504; Column 12, lines 54-56) on the graphical user interface (Wygodny: fig.5), wherein the graphical user interface is used for editing the plurality of column oriented programming language statements individually (Wygodny: fig.5 item #501), and wherein the graphical user interface is adapted to receive content for the one or more editable fields from the user to define the at least one of the plurality of column oriented programming language statements (Wygodny: fig.5 item #504). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a plurality of panes

on a graphical user interface in Reulein's system. One would have been motivated to include a plurality of panes on a graphical user interface to show different option such as filter tree pane #501 and a source code pane #504 (Wygodny: fig.5: items #501 and #502; Column 12, lines 54- 56).

Claims 2, 9, 16 and 23: Reulein in view of Wygodny discloses method, system and product of claims 1, 8, 15, & 22 respectively and further comprising permitting the at least one of the plurality of column oriented programming language statements to be selected by the user for replacement (Reulein: Paragraph [0042], lines 6-12).

Claims 3, 10, 17 and 24: Reulein in view of Wygodny discloses method, system and product of claims 2, 9, 16, & 23 respectively and further comprising permitting a position in the plurality of column oriented programming language statements to be selected by the user for insertion of the at least one of the plurality of column oriented programming language statements (Reulein: Paragraph [0042], lines 6-14).

Claims 4, 11, 18 and 25: Reulein in view of Wygodny discloses method, system and product of claims 3, 10, 17, & 24 respectively and further comprising displaying a field difference indicator on the graphical user interface for each of the one or more editable fields whose contents has been changed by [[said]] the user (Reulein: Paragraph [0032], lines 5-8).

Claims 5, 12, 19 and 26: Reulein in view of Wygodny discloses method, system and product of claims 4, 11, 18 & 25 respectively and further comprising one of: selectively replacing the at least one of the plurality of column oriented programming language statements; and inserting the at least one of the plurality of column oriented programming language statements in the first pane (Wygodny: Column 21, lines 11-17).

Claims 6, 13, 20 and 27: Reulein in view of Wygodny discloses method, system and product of claims 5, 12, 19 & 26 respectively and further comprising displaying a user selectable apply button on the graphical user interface for initiating said one of the selectively replacing and the inserting (Reulein: Paragraph [0075], lines 9-16).

Claims 7, 14, 21 and 28: Reulein in view of Wygodny discloses method, system and product of claims 1, 8, 15, & 22 respectively; the template description is an extensible mark-up language document. (Reulein: Paragraph [0024], lines 9-16).

NEW GROUND(S) OF REJECTION

The following new ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the following means plus function limitation: *"means in the recordable type medium for identifying a template description for at least one of the plurality of column oriented programming language statements, wherein the template description defines at least one statement type, and wherein the at least one of the plurality of column oriented programming language statements is selectable in a first pane of a plurality of panes on a graphical user interface."*

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase "means for" or "step for" (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC

§ 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function: Figures 4 and 5; Specification pages 7 and 22-24.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. It appears that the claimed means is broadly described on pages 7 and 22-24 of the specification and broadly shown in figures 4 and 5.

However the specification does not specifically describe how the recited function is performed. Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed function.

More specifically, the specification in pages 7 and 22-24 describes the content of the template and indicates the template description defines the statement type. The specification also provides the function in detail and indicates that the at least one of the plurality of column oriented programming language statements is selectable in a first pane of a plurality of panes on a graphical user interface.

While the specification details the content of the template description or the template string, the specification fails to indicate what means is utilized to do the identifying function of the template description. The specification also fails to describe the details of the specific algorithm that actually performs the identifying function of the template description, i.e., means for identifying the template description.

Claims 23-28 depend from claim 22 and are rejected for the reasons set forth in connection with the rejection of claim 22 above.

(10) Response to Argument

Regarding claims 1 (8, 15, and 22):

Appellant argues that Reulein fails to teach "identifying a template description for at least one of the plurality of column oriented programming language statements" because all of the rules of Reulein are defined in the table. The Examiner respectfully disagrees since Reulein teaches replacing a component with a different component from the repository ([0075]). As such, Reulein reasonably teaches "identifying a template description..."

Appellant arguments "Further, as stated in the Office Action, Reulein fails to disclose, "a plurality of panes on a graphical user interface." Therefore, Reulein fails to teach or suggest the features as currently claimed in claim 1." The Examiner notes that this argument attacks the Reulein reference individually since rejection relies on Wygodny to teach this feature.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues that Wygodny neither teaches nor suggests "editable fields corresponding to the at least one statement type" as currently claimed.....Wygodny does not allow the editing of the programming language statements". The Examiner respectfully disagrees since the check boxes can be associated with different value (check or unchecked), it is reasonable to interpreted those check boxes as "editable fields".

Appellant further argues Wygodny teaches away from the invention of claim 1. However, as explained above, since the check boxes can be associated with different value (check or unchecked), it is reasonable to interpreted those check box as "editable fields. As such, Appellant argument is not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Appellant argument "No Proper Reason Stated Under KSR", it is noted that the Supreme Court has held that "a patent for a combination which only unites old elements with no change in their respective functions...obviously withdraws what is already known into the field of its monopoly and diminishes resources available to skillful men...The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745, (U.S. 2007).

"Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle...the fact that a combination was obvious to try might show that it was obvious under section 103." *KSR Int'l Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745, (U.S. 2007).

When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious. *Sakraida v. AG Pro, Inc.*, 425 U.S. 273 (1976).

Regarding claims 2 (9, 16, and 23):

Appellant argues that the combination does not teach "permitting the at least one of the plurality of column oriented programming language statements to be selected by the user for replacement." The Examiner respectfully disagrees. As explained above, since Reulein teaches replacing a component with a different component from the repository ([0075]) and Wygodny teaches selectable editable fields, the combination would reasonably teach "permitting the at least one of the plurality of column oriented programming language statements to be selected by the user for replacement."

Regarding claims 3 (10, 17 and 24):

Appellant argues that Reulein fails to teach insertion of a task as claimed. It is noted that "task" is not recited in the claim. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., task) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Reulein's replacement of a component with another component can be reasonably interpreted as another component is inserted.

Regarding claims 4 (11, 18, and 25):

Appellant argues that the combination does not teach or suggest "displaying a field difference indicator on the graphical user interface for each of the one or more editable fields whose contents has been changed by the user." The Examiner

respectfully disagrees. Reulein teaches using color and boxes to indicate the status of the project, Wygodny teaches selectable editable fields, content of which can be changed (checked/unchecked). As such, the combination reasonably teaches "displaying a field difference indicator on the graphical user interface for each of the one or more editable fields whose contents has been changed by the user."

Regarding claims 5 (12, 19 and 26):

Appellant argues that the combination does not teach "selectively replacing the at least one of the plurality of column oriented programming language statements; and inserting the at least one of the plurality of column oriented programming language statements in the first pane." since "Wygodny does not teach selectively replacing and inserting statements, as claimed". The Examiner respectfully disagrees since Reulein teaches replacing a component with a different component from the repository ([0075]), the combination of Reulein and Wygodny reasonably teaches the claimed feature.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

TH

Conferees:

/Tadesse Hailu/
Primary Examiner, Art Unit 2173 6/11/2010

/Kieu Vu/
Supervisory Patent Examiner, Art Unit 2173

/William L. Bashore/
Supervisory Patent Examiner, Art Unit 2175

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Acting Director TC 2100

/Meng-Ai An/
Supervisory Patent Examiner, Art Unit 2195